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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/810,720  | 03/29/2004  | Byung-Jin Kim        | 1740-000011/US/COA  | 9364             |
| 30/593 7590 04/09/2008<br>HARNESS, DICKEY & PIERCE, P.L.C.<br>P.O. BOX 8910<br>RESTON, VA 20195 |             |                      |                     |                  |
| EXAMINER<br>CHEVALIER, ROBERT   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 2621  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 04/09/2008  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/810,720

**Applicant(s)**

KIM ET AL.

**Examiner**

ROBERT CHEVALIER

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 10-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6 and 10-25 is/are rejected.
- 7) ☒ Claim(s) 2, 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 1, 3-4, 6, and 10-25, have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-4, 6, are rejected under 35 U.S.C. 102(e) as being anticipated by Nakano et al (P.N. 2002/0057899).

Nakano et al discloses a video reproducing apparatus that shows all the limitations recited in claims 1, 4, including the feature of outputting an I picture and a number of P-pictures as still picture based on reproduced video data as specified in the present claims 1, 4. Applicant's attention is directed to Nakano et al's claim 13, wherein it is disclosed that reproducible video data is decoded using a decoding portion and video still picture data is generated from the decoded video data using still picture coding portion.

With regard to claims 3, 6, the feature of the number of P-pictures being greater than 1 would be present in Nakano et al. (See Nakano et al's Figure 6).

4. Claims 10-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Murase et al (P.N.6,424,797).

Murase et al discloses a video recording/reproducing apparatus that shows all the limitations recited in claims 10, 13-15, 19, 21, and 23-25, including the feature of the data area for storing video data and the management area storing management data indicating if the video data does not include a still picture as specified in the present claims 10, 13-15, 19, 21, and 23-25. Applicant's attention is directed to Murase et al's column 6, lines 31-39, where it is disclosed management information including the capability of indicating whether still picture will be reproduced during the reproduction of the video data from the recording medium.

With regard to claims 11, 16, the feature of the management information including identification information for identifying a portion of the video data including the still picture as specified thereof would be present in Murase et al. (See Murase et al's column 6, lines 47-57).

With regard to claims 12, 17, the feature of the recording medium being an optical disc as specified thereof is present in Murase et al. (See Murase et al's column 6, line 29).

With regard to claims 18, 20, 22, the feature of the management area and the data area being separated by at least one header area including header information for the video data as specified thereof is present in Murase et al. (See Murase et al's Figure 1, where it is disclosed that the management data and the AV data are recorded as different files, and further, see Murase et al's Figures 2, and 37, where it is disclosed

that the video pack of the video data includes packet data and packet header which packet header would separate the management data from the video data).

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 10-12, 15-18, 22, and 25, are rejected under 35 U.S.C. 101 because the claim is directed to a recording medium storing nonfunctional descriptive material. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. See, e.g. Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP 2106.IV.B.1.

As indicated in the previous Office Action, these claims only call for two different recording areas having video data and management data recorded thereon. The management data is described as for managing reproduction of the video data. Therefore, it is noted that these data as specified in the claimed invention only describe the intended use thereof. These data as presented in the claimed invention do not provide any functional descriptive material. As such, it is determined that the claim is directed to a recording medium storing nonfunctional descriptive material.

5. Claims 2, 5, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT CHEVALIER whose telephone number is (571)272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROBERT CHEVALIER/

Application/Control Number: 10/810,720

Page 6

Art Unit: 2621

Primary Examiner, Art Unit 2621

April 4, 2008.